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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,030	09/23/2002	George H. Scarfos III	P22,816A USA	3525

7590 09/10/2004

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EXAMINER

MERTZ, PREMA MARIA

ART UNIT PAPER NUMBER

1646

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/018,030	SEARFOS III ET AL.	
	Examiner	Art Unit	
	Prema M Mertz	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/US00/09178. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions, which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I. Claims 1, 3, 5, drawn to a DNA encoding a TRAF2TR protein and the protein encoded thereby.

Group II. Claims 2, 4, 6, drawn to a DNA encoding a TRAF2TD protein and the protein encoded thereby.

Group III. Claims 7-8, 12-13, 17-18, 22-23, 27-29, drawn to a method of treatment by administering a vector capable of expressing TRAF2TR protein.

Group IV. Claims 7, 9, 12, 14, 17, 19, 22, 24, 27-29, drawn to a method of treatment by administering a vector capable of expressing TRAF2TD protein.

Group V. Claims 7, 10, 12, 15, 17, 20, 22, 25, 27-29, drawn to a method of treatment by administering a TRAF2TR protein.

Group VI. Claims 7, 11, 12, 16, 17, 21, 22, 26, 27-29, drawn to a method of treatment by administering a TRAF2TD protein.

Group VII. Claims 30-31, drawn to a DNA encoding a TRAF2TR/2TD variant.

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Group VIII. Claim 32, drawn to a TRAF2TR/2TD variant.

Should any one of the Groups from 1-VIII be elected, Applicant is required to select one polypeptide (one amino acid sequence). Once one polypeptide sequence is selected, all other sequences will be withdrawn from consideration.

Applicants are advised that to comply with the sequence rules, the recitation of the Figure numbers in claims 1-2 and 5-6 should be deleted and the specific SEQ ID NOs be recited in the claims. The recitation of both the Figure numbers and the SEQ ID NOs would be redundant.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

The first claimed invention encompasses a DNA and the TRAF2TR protein encoded by such DNA. The nucleotide sequence and the specific amino acid sequence encoded by the DNA are the special technical feature of the invention. However, the second claimed invention fails to recite such a feature, because the second claimed invention encompasses a DNA and the TRAF2TD protein encoded by such DNA. Therefore, the other claimed inventions cannot share a special technical feature with the first claimed invention. Similarly, the inventions of Groups VII-VIII do not share a special technical feature with the invention of Group I because the special technical feature of Group I is absent from Groups VII-VIII. The methods of Groups III-VI are patentably distinct because each recites starting materials not required by the other, and the search of all the methods in one patent application would result in an undue search burden.

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3. Claims 27-29 are generic to a plurality of disclosed patentably distinct species comprising the list of diseases recited in the claims. Applicant is required under 35 U.S.C. 121 to elect a single disclosed disease, even though this requirement is traversed.

Should applicant traverse on the ground that the different diseases are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the diseases to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Prema Mertz
Prema Mertz Ph.D.
Primary Examiner
Art Unit 1646
August 18, 2004